

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Volker Stade	Confirmation No.:	8582
Serial No.:	10/646,376	Art Unit:	1734
Filed:	August 21, 2003	Examiner:	Mark A. Osele
For:	HAND-HELD DEVICE FOR TRANSFERRING A FILM ONTO A SUBSTRATE AND HAVING AN APPLICATION MEMBER COMPRISING A PLURALITY OF APPLICATION EDGES	Attorney Docket No.:	11349-18-999
		CAM No.:	662855-999018
		Date:	February 14, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the Final Rejection mailed November 14, 2006 ("Final Rejection") of the above-identified application prior to filing an appeal brief for the reasons set forth below.

Independent claim 1 is provided below:

1. A hand-held device for transferring a film from a backing tape onto a substrate, said device comprising:

a housing in which a supply of the backing tape is arranged; and

an application member projecting from said housing and having a front end with a free end and at least a first application edge and a second application edge, the backing tape being wound around said free end and said application edges of said application member and extending into said housing with tape sections at a lower longitudinal side of said application member facing the substrate during operation and at an upper longitudinal side of said application member opposite said lower longitudinal side; wherein:

said second application edge projects from said lower longitudinal side of said application member,

said first application edge and said second application edge are linear,
and

said first application edge and said second application edge are arranged asymmetrically in relation to a longitudinal axis of said application member.

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Manusch et al. (US 6,105,650), noting that Manusch discloses, among other things, a first application edge (Figure 2, application toe 4a) and a second application edge (Figure 2, application toe 4b), where the second application edge (Figure 2, application toe 4b) projects from the lower longitudinal side of the application member (column 6, lines 32-61) and the first and second application edges are arranged asymmetrically in relation to a longitudinal axis of the application member (Fig. 3; column 7, lines 26-41; column 8, lines 13-23, in particular lines 13-16).

Applicant submits that the sections cited above would not teach a person of ordinary skill in the art the hand-held device including the features recited above in claim 1. More specifically, Manusch discloses two different embodiments of a correction tape device (see, e.g., col. 5, lines 8 – 27). A first embodiment according to Fig. 1 has an integrally formed application member. However, this integrally formed application member is said to be “substantially symmetrical in construction” (see, e.g., col. 6, lines 17, 18). A second embodiment of Fig. 2 and Fig. 3 relies on a non-integral design as otherwise the relative displacement (translational or rotational) of the parts 4a, 4b could not be achieved. It is simply technically impossible to achieve the displacement necessary in the embodiment of figures 2, 3 in an integral design.

Independent claim 27 includes the features recited in claim 1 above and further includes a feature that the first application edge, the second application edge and the application member are integral.

The Examiner rejected claim 27 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a), as obvious over Manusch et al., noting that Manusch discloses, among other things, that “the application member and second application edge are not integral with each other, but this is disclosed as ‘...an embodiment for the arrangement as a whole’ (col. 7, lines 26, 27). The use of the article ‘an’ suggests that other embodiments are contemplated, such as the integral and non-integral constructions of the application feet and application toes are interchangeable (col. 6, lines 52-54).” In addition, the Examiner noted on page 7 of the office action that “[a]s shown in Fig. 3 of Manusch et al. ‘650, a connector 22a, 22b, attaches the second application edge to the lower longitudinal side of the application member.” Applicant submits that the latter statement is correct, i.e., that according to the embodiment of Fig. 3 of Manusch, a connector attaches the

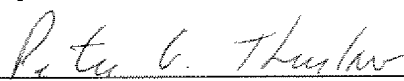
second application edge to the lower longitudinal side of the application member, which clearly explains that there is not an integral design.

For the reasons mentioned above, Applicant hereby requests that this case either be allowed on the merits or to reopen prosecution accordingly.

Applicant's undersigned attorney may be reached in our New York Office at the phone number below. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

Date: February 14, 2007


Peter G. Thurlow 47,138
JONES DAY (Reg. No.)
222 East 41st Street
New York, New York 10017
(212) 326-3694